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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,182	09/17/2003	Wayne Charles Hasz	RD-26,391-4	8762
6147	7590	02/13/2006	EXAMINER	
GENERAL ELECTRIC COMPANY GLOBAL RESEARCH PATENT DOCKET RM. BLDG. K1-4A59 NISKAYUNA, NY 12309			JOHNSON, JONATHAN J	
			ART UNIT	PAPER NUMBER
			1725	
DATE MAILED: 02/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,182

Applicant(s)

HASZ ET AL.

Examiner

Jonathan Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
4a) Of the above claim(s) 2-8 and 15-27 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 9-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 2-8, 15-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1-9-06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,714,202 (Lemelson). Lemelson teaches attaching a preform to the substrate (col. 4, l. 51), the preform comprising braze alloy and wear-resistant particles (col. 4, ll. 50-56); and bonding the preform to the substrate to form a wear-resistant coating (col. 4, ll. 55-65); wherein the wear-resistant particles comprise diamond (col. 4, l. 55).

Claims 1, 9, 10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,190,124 (Freling). Freling teaches attaching a preform to the substrate (figure 4, item 38), the preform comprising braze alloy and wear-resistant particles (Figure 4, item 38 and 42); and bonding the preform to the substrate to form a wear-resistant coating (abstract); wherein the wear-resistant particles comprise a ceramic material; wherein the ceramic material comprises at least one of a carbide and an oxide (col. 4, ll. 5-45); wherein the oxide comprises at least one of aluminum oxide and yttrium oxide (col. 4, ll. 5-45).

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Claims 1, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2,763,920 (Turner). Turner teaches attaching a preform to the substrate (col. 2, ll. 20-25), the preform comprising braze alloy and wear-resistant particles (col. 3, ll. 10-60); and bonding the preform to the substrate to form a wear-resistant coating (col. 2, ll. 20-25); wherein the ceramic material comprises at least one of a carbide and an oxide; wherein the carbide comprises at least one of chromium carbide and tungsten carbide (col. 3, ll. 30-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,190,124 (Freling) as applied to claim 1 above and further in view of JP 3-232707 (Akiyama). Akiyama teaches a relationship between wear resistance and the nm-sized powder. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the powder of Freling to utilize the claimed nm powder in order to improve wear-resistance (see Akiyama abstract).

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., where the

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preform is a brazing sheet that contains no binder) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues the claim 1 limitation of "preform" should be construed to mean "brazing sheet that contains no binder" and cites page 7, ll. 1-6 and page 9, ll. 18-20 of the specification to support his position of the special definition. The examiner disagrees. Both citations merely give different examples or embodiments of how a wear resistant coating can be formed on a substrate. Thus, contrary to the applicant's belief, the present specification contains no special definition for the term "preform." It is appropriate, therefore, to give the term its broadest reasonable interpretation. During patent examination, the pending claims must be "given the broadest reasonable interpretation." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In the instant case, m-w.com defines "preform" as "to form beforehand." In applying the Prater test by giving the claim term its broadest reasonable interpretation, it is the examiner's position that applying nickel onto the McrAlY coated substrate prior to applying the diamond coating would make the nickel part of the "preform" as the nickel would be formed beforehand or prior to the formation of the final product. Similarly, Freling's preform are features 38, 42, and 44 and are formed prior to the formation of the final product.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 571-272-1177. The examiner can normally be reached on M-Th 7:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jonathan Johnson
Primary Examiner
Art Unit 1725

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